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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,848	02/22/2002	Michael Musarella	87185-3300	7571
28765	7590	08/25/2005	EXAMINER	
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			ELKINS, GARY E	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/079,848	Applicant(s) MUSARELLA ET AL.	
	Examiner Gary E. Elkins	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-43 is/are pending in the application.
- 4a) Of the above claim(s) 4, 10, 18-22, 29-31, 33-37 and 42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 11, 12, 14-17, 23-27, 32, 38-41 and 43 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly added claim 42 is not considered readable upon the elected embodiment of fig. 15. Accordingly, claim 42 has been withdrawn along with claims 4, 10, 18-22, 29-31 and 33-37.

Claim Rejections - 35 USC § 112

2. Claims 17 and 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 3, "the tool holding portion" lacks antecedent basis in the claims.

In claim 39, lines 4 and 5, "wider than any restricting facing the restricting portion..." is unclear grammatically, i.e. wider than any restricting what? Does this mean wider than any *restriction* facing...?

In claim 40, "to receive the article therebetween form hooking" is unclear in meaning.

In claim 41, "the a mounting portion" is unclear grammatically and lacks antecedent basis in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn '342.

Kahn '342 discloses a tool holder including first support member 10b and second support member 10a connected to the first support member at connection portion 10c. Tool holding members 30, 40 are mounted to the second support member 10b and are considered capable of holding a hand-held tool having a diameter of at least ½ inch. With respect to claim 17, each tool holding member is considered to include a recess capable of holding the handle of a hand-held tool. It is noted that no distinction is seen between the tool holder claimed and that of Kahn '342 as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture.

5. Claims 1-3, 11, 23-27, 32 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Gagne. Gagne discloses a first support member 118, second support member 102 connected to the first support member at a connection portion 110 and a holding member 109 mounted to support member 102. No distinction is seen between the holder claimed and that shown in Gagne as a result of the claimed intended use with a handheld tool, i.e. the holder 109 of Gagne is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Gagne as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. With respect to claim 11, note is made of the recess within element 114 and the corresponding shaped portion 112 of the tool holding member. With respect to claims 25 and 26, note is made of the connection portion 110 of Gagne which includes an extension and a recess which are respectively locked into position via the pivot pin.

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6. Claims 1, 2, 32, 39 and 40 are rejected under 35 U.S.C. 102(a) as being anticipated by Skaggs. Skaggs discloses a holder including first support and second support members 16 connected to each other at connection portion 36. Holding member 32 is mounted to the second support member. No distinction is seen between the claimed holder and that shown in Skaggs as a result of the claimed intended use with a handheld tool, i.e. the holder of Skaggs is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Skaggs as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture.

7. Claims 1, 2, 11, 12, 14, 15, 38-41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Kahn '449. Kahn '449 discloses a first support member 10b, second support member 10a connected to the first support member at a connection portion 10c and a holding member 30 mounted to support member 10a. No distinction is seen between the holder claimed and that shown in Kahn '449 as a result of the claimed intended use with a handheld tool, i.e. the holder of Kahn '449 is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Kahn '449 as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. With respect to claim 11, note is made of the recess 11 or 23 and the corresponding shaped portion 12, 30a of the tool holding member. With respect to claims 12, 14 and 15, the holder 30 in Kahn '449 is considered movable to a retracted position against the side of a person insofar as claimed. With respect to claim 43, the

first and second support members in Kahn '449 are considered to "of separate construction" insofar as they are formed differently.

8. Claims 1, 2, 9, 32, 38, 39, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Musarella et al (fig. 7 emb). Musarella et al discloses a first support member 12LRC, 12RRA, 12A, second support member 12LF or 12RF connected to the first support member at a connection portion 12LM or 12RM and a holding member 314A mounted to one of the support members 12RF and 12LF. It is noted that no distinction is seen between the tool holder claimed and that of Musarella et al as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. With respect to claim 9, Musarella et al is considered to include legs 12LRA, 12RRA extending along more than half of the height of the first support member as claimed. With respect to claims 12, 14 and 15, the holder 30 in Kahn '449 is considered movable to a retracted position against the side of a person insofar as claimed. With respect to claim 43, the first and second support members in Kahn '449 are considered to "of separate construction" insofar as they are formed differently.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Kahn '449, Skaggs or Gagne, each in view of either Thurman or Karpati. Each of Kahn '449,

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Skaggs and Gagne discloses all structure of the claimed holder except a first support member which is curved to conform to the waist of a user. Each of Thurman and Karpati teaches that it is known to curve a holder adjacent a user to provide more comfort during use. It would have been obvious to curve the first support member in any one of Kahn '449, Skaggs or Gagne as taught by either Thurman or Karpati to provide a more comfortable fit during use.

Allowable Subject Matter

11. Claims 6 and 28 are allowed.
12. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. It is noted that the withdrawal of the previous indication of allowability of claim 7-9 in light of newly applied prior art rejection in paragraph 8 and 10 above is regretted.

Response to Arguments

14. Applicant's arguments with respect to claims 1-3, 7-9, 11, 12, 14-17, 23-27, 32, 38-41 and 43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The remaining cited prior art is illustrative of the general state of the art.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (571)273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday through Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Nathan Newhouse can be reached at (571)272-4544.



Gary E. Elkins
Primary Examiner
Art Unit 3727

gee
22 August 2005